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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,248	06/01/2001	Masahiro Shioji	010721	8234

38834 7590 07/28/2005

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EXAMINER

WILSON, JACQUELINE B

ART UNIT	PAPER NUMBER
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2612

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/871,248

Applicant(s)

SHIOJI, MASAHIRO

Examiner

Jacqueline Wilson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4 and 5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4 and 5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/08/05 has been entered.

Response to Arguments

1. Applicant's arguments filed 06/27/05 have been fully considered but they are not persuasive.

The applicant argues that the prior art fails to specifically teach the digital camera further comprising: a file number assigner for assigning file numbers capable of being overlapped between the folder of the image files..." The examiner disagrees. Although Endo et al teaches a file number assigner for assigning file numbers capable of being overlapped between the folders of the image files, the claimed limitation "capable of" is interpreted as performing the task, but not necessarily doing it. This limitation is considered a functional limitation that attempts to define something by what it does or by a property or characteristic it has, rather than by what it is (see MPEP 2173.05(g)). In this case, the file number assigner is capable of assigning file numbers overlapped between the folders to the image files. Therefore, the rejections are maintained.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. ^{1-2 and 4-5}
Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Endo et al (US 6,763,182).

Regarding Claim 1, Endo et al teaches an attacher (referred to as memory card controller 9) attached with a recording medium (memory card 2) forming a plurality of folders for managing a plurality of image files (see figs. 2, 4A and 4B; col. 4, lines 17+ teaches a plurality of folders referred to as sub-directories for still and moving images). Endo et al further teaches a control micro-computer (7) which inherently has a pointer for pointing to any one of the plurality of folders formed in the recording medium (2) as a record destination depending on the type of image being captured (still or moving; col. 5, lines 5-50). This reads on the limitation of a first pointer to point at any one of the folders as a record destination. Endo et al also teaches the control micro-computer (7) inherently has a pointer for pointing to any one of the plurality of folders formed in the recording medium (2) for reproducing images (still or moving; col. 5, lines 51+). This

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reads on the limitation of a second pointer to point at any one of the folders as a reproducing destination folder. Endo et al further teaches an imaging device (3), a writer (7) for writing a new image file (col. 5, lines 24+) including image data of the subject image which is imaged by the imaging device (3) to the record destination folder when a recording instruction is issued and a first changer (referred to as setting the camera to a reproduction/playback mode or recording mode indicated by a shutter button 14 in which the changeover switch 13 sets the camera into the selected mode; col. 5, lines 5-8 and 51-54). This first changer (changeover switch 13) switches changes a point destination of the second pointer (which indicates the image to be reproduced) to a point destination of the first pointer (the image to be recorded in a specific location according the a recording instruction; activating the shutter button 14 for image capture). This is interpreted this as changing the point destination of the second pointer to a point destination of the first pointer (changing from a location of reproducing to a location of recording). Endo et al further teaches a reproducer (referred to as picture display unit 5) for reproducing an image file stored in the reproducing destination folder when a reproducing instruction is issued (col. 5, lines 52-col. 6, line 5). Endo et al also teaches a file number assigner for assigning file numbers capable of being overlapped between the folders to the image files (col. 5, lines 23-35). The limitation of "capable of being" is interpreted as performing the task, but not necessarily doing it. This limitation is considered a functional limitation that attempts to define something by what it does or by a property or characteristic it has, rather than by what it is (see MPEP 2173.05(g)). Also broadly interpreting this limitation, figure 2

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shows folders 100 MSDCF and MOML0001 include image files DSC*****.JPG and MOV*****.MPG as being overlapped since the order of the images are in an overlapping manner. Also Endo et al teaches a third pointer having a file number of a file to be reproduced (col. 6, lines 10+), wherein the image file to be reproduced is specified by the second pointer and the third pointer (the micro-computer 7 indicates which folder, still or moving, is to be reproduced and also when image file selected for viewing).

Regarding Claim 2, Endo et al teaches a folder number assigner (col. 4, lines 8-33) for assigning different folder numbers respectively to the folders formed in the recording medium, wherein the first pointer holds a folder number of the record destination folder, the second pointer holds a folder number of the reproducing destination folder, the first changer sets a folder number held by the first pointer to the second pointer (col. 5, lines 6-67).

Regarding Claim 4, Endo et al teaches that depending on the mode selected by the changeover switch will determine is recording or reproducing images will be performed (col. 3, lines 37+). Once the changeover switch (13) switches to another position once a shutter button (14) is activated for recording, the micro-computer (7) performs the function of recording (col. 3, lines 55+). It is inherent that if the file number held by the third point is changed to a file number of the new image file (as created by the micro-computer, col. 5, lines 24-25) upon activation of a recording instruction (shutter button 14).

Regarding Claim 5, Endo et al teaches a selector (col. 5, lines 60+) for selecting an arbitrary folder as the reproducing destination folder and a third changer (inherently

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located in the micro-computer 7) for changing only the pointing destination of the second pointer among the first pointer and second pointer to a folder selected by the selector (col. 5, lines 13+).

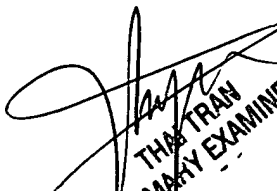
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline Wilson whose telephone number is (571) 272-7322. The examiner can normally be reached on 8:30am-5:00pm (alternate Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ^{Thai Tran} ~~Wendy Garber~~ can be reached on (571) 272-⁷³⁸² ~~7308~~. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JW
07/21/05


THAI TRAN
PRIMARY EXAMINER